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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,350	04/20/2004	Claudio Terruzzi	TERRUZZI1	2614

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EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No.		Applicant(s)	
	10/827,350		TERRUZZI, CLAUDIO	
	Examiner		Art Unit	
	Elizabeth D. Wood		1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/7/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Specification

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 15 refer to "perlex" which would appear to be a trade name.

Claim 9 is improper because it makes very little sense. It appears to refer to claim 1, but seems to contain limitations that would be broader than claim 1, for

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example, claim 1 requires cement but it is not clear whether such is present in the "vehicle" of claim 9.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition comprising a photocatalyst, does not reasonably provide enablement for a composition that is silent with respect to a photocatalyst. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification would appear to consider a photocatalyst to be a required component of the instant composition. The specification clearly indicates that the cement paint should contain a photocatalyst to achieve the advantages of the invention on page 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,495,228 to Cornwell.

The instantly claimed invention of which claim 1 is representative comprise a material for application to cement that comprise cement, liquid, calcium carbonate aggregate, glass aggregate and a photocatalyst.

Cornwell discloses a material having utility as a protective coating comprising titanium dioxide (a photocatalyst), other pigments that may be added, calcium carbonate aggregate in sizes commensurate with those claimed herein and glass frit, substantially as claimed herein by applicant.

Cornwell et al. does not specifically disclose the size of the frit, or the identity thereof.

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The instantly claimed invention would have been obvious, however, because one skilled in the cement art is aware that the selection of small particle sizes such as those claimed herein is an obvious modification and selection of smaller sizes would result in denser material with more consistent, homogeneous characteristics. Selection of AR resistant glass is obvious in view of the environment of the cement, and E glass is a known component of cementitious materials due to the desirable properties of this glass.

Note claim 9 has been included in this rejection. As explained in the hereinabove rejection under 35 USC 112, the examiner considers this claim so indefinite that it has been difficult to interpret for the purposes of an art rejection; however the examiner has treated the claim **at this time** as being dependent on claim 1 and therefore differs from claim one only in defining the fluidizing liquid. It may be, however, that applicant intends this claim to be broader than claim 1 and to not contain cement, pigment or the particle sizes of the ingredients. If the claim is rewritten in this manner, the finality of this office action will still be maintained.

Regarding claims 10-18, they recite only a dry material comprising calcium carbonate, cement and glass that is adequately disclosed by Cornwell, as explained hereinabove.

Claims 10-12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,162,182.

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These claims recite a dry material comprising calcium carbonate, glass and cement.

EP 1,162,182 discloses compositions containing cement, a coarse aggregate and calcium carbonate aggregate, the aggregates overlapping in size with those claimed herein. A photocatalyst is also present. See the claims.

This reference differs from the instant claims in the failure to recite specifically a "vitreous" material. However, as such is not defined by the instant specification, the examiner has broadly defined vitreous to mean having some glassy or crystalline character, and the aggregates disclosed by the reference such as fly ash or silica fume can conceivably be considered to have glassy or crystalline character.

Any minor differences in the limitations of the dependent claims have been considered, such as the use of aminosilane agglomerating materials. Such is considered to have been obvious and within the skill of the art, and fairly shown as such by some of the prior art of record. There is nothing unobvious in using a material such as a binding agent for its intended purpose. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. If applicant believes that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Sample can be reached at 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth D. Wood
Primary Examiner
Art Unit 1755

edw